

### **REMARKS**

Claims 19-22, 24-34 and 41-42 are pending. Claims 19-22 and 24-34 stand rejected. Applicants respectfully request entry of the claim amendments above as they are believed to put the claims in condition for allowance or, alternatively, in better form for consideration on appeal. Thus, entry under 37 CFR 1.116 is correct. The claims are amended and claims 23 and 35-40 are canceled without prejudice to or disclaimer of Applicants' right to pursue the canceled subject matter of these claims in a later application. No new matter has been added.

Claims 19, 21 and 22 are amended to clarify the method. Claim 19 is further amended to incorporate the subject matter of claim 23 and original claim 16. Claims 41 and 42 are added replacing canceled claims to more clearly recite the method of the invention. Support for the amendment and the new claims is found in original claims 1 and 16, previously presented claims 19 and 23, in the specification on page 10 lines 15-30 and in Example 8 on pages 14-16. No new matter has been added.

### **Election/Restrictions**

In response to the restriction requirement set forth in the Office Action mailed March 2, 2006, Applicants hereby provisionally elect Group I, claims 19-27 and 32-34, with traverse. Applicants respectfully request reconsideration of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression 'special technical feature' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (PCT Rule 13.2).

The Examiner alleges that the inventions listed as Groups I-V do not relate to a single inventive concept. The Examiner has characterized the special technical feature as a plant

comprising an extra copy of an ATP/ADP translocator gene, stating that this was known in the art, citing Sijmons et al. Applicants respectfully disagree with the Examiner's conclusions and characterization of the reference and of the special technical feature of the invention.

Applicants' previously presented claims were not drawn to the transformed plant but were drawn to a method of using a transformed plant having modified amino acid content. Sijmons et al. does not teach or disclose such a method and does not mention modifying the amino acid content of a plant. Therefore, the Patent Office has not established the presence in the prior art of the special technical feature of Applicants' claims as previously claimed or as amended. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application.

The Examiner further alleges that the newly submitted claims 28-40 are directed to an invention that is independent from the invention as originally claimed and not within the originally elected group. Applicants respectfully disagree. However, to expedite prosecution, Applicants canceled without disclaimer or prejudice claims 35-40 (Groups III-V). Applicants respectfully request reconsideration regarding claims 28-31. Claims 19-22, 24-34 as amended and new claims 41-42 are all drawn to a method of modifying the amino acid content of a plant cell, plant tissue, or plant and a method of using a plant with modified amino acid content as a foodstuff (see specification at page 10 lines 15-30 and original claim 16). These claims correspond to the original election (see Office Action mailed July 29, 2004, Group I, claim 1-16, drawn to a first product, a first method of making and a first method of using said transformed plant). Furthermore, the method of claim 19 is shared by claims 20-22 and 24-34, because these claims depend directly or indirectly from claim 19. Because all the claims share the same or a corresponding technical feature, unity of invention is fulfilled pursuant to 37 CFR § 1.475. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine at least claims 19-22, 24-34 and claims 41-42 in one application.

Furthermore, unity of invention was found during the International stage. As shown in the International Preliminary Examination Report and International Search Report, all claims

were searched and examined together. Thus application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine all groups. As previously noted, this is a national stage application from a PCT application, and all the groups were searched by the International Search Authority and the International Examination Authority. Applicants respectfully submit that the restriction requirement should be withdrawn even under restriction practice. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, there would be no undue burden on the Examiner to examine the entire application.

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn. However, because this action is made final, Applicants provisionally elect Group I, claims 19-27 and 32-34 with traverse and cancel claims 28-31 without prejudice or disclaimer in order to be fully responsive if the Examiner disagrees with the request for reconsideration and maintains the constructive election of claims 19-27 and 32-34.

### **Double Patenting Rejection**

Claims 19-27 and 32-34 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 6-7, 10, 12-13, and 16-19 of U.S. Patent No. 6,891,088 (the ‘088 patent).

Applicants respectfully traverse the double patenting rejection.

The Examiner alleges that the only active step in either the ‘088 patent and the claims of the present application is transformation with an ATP/ADP translocator gene and as such the

claims of the '088 patent allegedly render obvious the claims of the present application. Applicants disagree that the '088 patent renders obvious the present invention. However, to expedite prosecution, the claims are amended to clarify the method. As amended, the claimed invention is a method for modifying the amino acid content of a plant cell, plant tissue, plant or progeny thereof, comprising growing a stably transformed, transgenic plant cell, plant tissue, plant or progeny thereof comprising an ATP/ADP translocator gene; and using said transformed plant cell, plant tissue, plant or progeny thereof as a useful plant or fodder plant with modified amino acid content (see specification page 10 lines 15-30 and original claim 16). The claims as amended are not drawn to a method of transformation. Furthermore, the '088 patent does not disclose or mention a method for modifying or increasing the amino acid content of a plant or using a plant as a useful or fodder plant with increased amino acid content. Thus, the claims as amended are not rendered obvious by the '088 patent. In light of the amendment, this rejection is believed to be rendered moot. Reconsideration and withdrawal of the double-patenting rejection is respectfully urged.

**Rejections under 35 U.S.C. § 102(b)**

Previously presented claims 19-27 and 32-34 stand rejected as being anticipated by *Tjaden et al.* (hereinafter "Tjaden").

Applicants respectfully traverse the anticipation rejection.

The Examiner alleges that the modified amino acid content is an inherent feature of a plant made by the method of transformation with an ATP/ADP translocator gene disclosed in Tjaden and claimed by Applicant. Applicants respectfully disagree that Tjaden teaches the claimed method. However, to expedite prosecution, the claims have been amended and relate to a method of modifying the amino acid content of a plant cell, plant tissue or plant and a method of using a plant with modified amino acid content (see specification at page 10 lines 15-30, original claim 16). Tjaden does not teach a method of modifying the amino acid content of a plant or a method of using a plant with modified amino acid content as a useful plant, fodder plant or foodstuff. There is no mention or disclosure in Tjaden of any amino acid content.

For these reasons, the cited reference does not anticipate the pending claims.

**CONCLUSION**

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance.

Accompanying this response is a petition for a two month extension of time to and including August 2, 2006 to respond to the Office Action mailed March 2, 2006 with the required fee authorization. Applicants are also filing a Notice of Appeal with this response with the appropriate fee authorization. No further fees are believed due.

If any additional fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13311-00001-US from which the undersigned is authorized to draw.

Respectfully submitted,

By   
Roberte M. D. Makowski, Ph.D.

Registration No.: 55,421  
CONNOLLY BOVE LODGE & HUTZ LLP  
1007 North Orange Street  
P.O. Box 2207  
Wilmington, Delaware 19899  
(302) 658-9141  
(302) 658-5614 (Fax)  
Attorney for Applicants